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DEC 21 2007

TECHNOLOGY CENTER 2100

In re Application of:)
James P. KARDACH)
Application No. 09/821,347) **DECISION ON PETITION**
Filed: October 16, 2003) **UNDER 37 CFR § 1.181**
For: DATA STORAGE MEDIUM HAVING)
INFORMATION FOR CONTROLLING BUFFERED)
STATE OF MARKUP DOCUMENT, AND METHOD)
AND APPARATUS FOR REPRODUCING DATA)
FROM THE DATA STORAGE MEDIUM)

This is a decision on the petition under 37 C.F.R. § 1.181 for Withdrawal of Finality of Office and Restarting of Period for Response filed.

The petition is **GRANTED**.

On 05 September 2005, Petitioner filed a response to an Office Action mailed 05 June 2007. In this response, claims 1-7 are amended to change “data storage” to “computer-readable”.

In an Office Action mailed 15 November 2007, the examiner finally rejected all claims 1-9. In this action, the examiner rejected claims 1, and 8-9 as being anticipated by Sullivan for the first time. Claims 1-9 are rejected under 35 USC 101 as being directed to non-statutory subject matter. The claims are alleged to store nonfunctional descriptive material and to include a carrier wave.

In the petition filed on 06 December 2007, Petitioner asserts that the final rejection is premature in that it includes three new grounds of rejection not necessitated by amendments. To buttress his position, Petitioner directs attention to paragraph 95 of the specification as originally filed which discloses that the invention includes “...permanent and removable storage, such as magnetic and optical discs, RAM, ROM, a carrier wave medium, etc...”. Petitioner also alleges that amendments made to claims 1-7 did not necessitate application of Sullivan as “the Examiner has not identified any element in Sullivan that can be considered to be a ‘computer-readable’ medium but not a ‘data storage’ medium”. Finally, Petitioner alleges that use of Goodman and the Heritage College Dictionary to define “interactive” in the Examiner’s response to arguments constitutes a new ground of rejection.

I. As noted in MPEP 706.07(a),

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

As acknowledged by Petitioner, neither "computer-readable" or "data storage" has antecedent basis in the specification. However, the portion of the specification that would provide support for these terms, paragraph 95, makes clear that the carrier wave medium, RAM, and ROM are all examples of storage. Thus, "data storage" and "computer-readable" mediums should both be interpreted to include carrier waves. Inclusion of the rejection of claims 1-9 under 35 USC 101 as including carrier waves for the first time in the Final Rejection was therefore inappropriate.

As to arguments presented traversing use of Sullivan as a basis of the rejection, the relevant issue is whether a previously applied reference could be used to address new limitations added to an amended claim, not whether a newly cited reference could be used to address limitations as originally presented. In this case, amending the claims from "data storage" to "computer readable" did not necessitate application of a new reference (Sullivan).

Finally, Goodman and the American Heritage College Dictionary were used to rebut arguments advanced by the Applicant. They do not form the basis of a rejection and are not considered a new ground of rejection.

II. As noted in MPEP 710.06,

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant.

Errors in the Office Action mailed 15 November 2007 are noted above, and Petitioner has requested that the period for response be restarted.

For the above stated reasons, the petition is **GRANTED**. The finality of the Office Action mailed on 15 November 2007 is hereby withdrawn and the status of that Action is changed to non-final. The period of response will be reset to start Three Months from the date of this Decision.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3591.

/Gail O. Hayes/

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